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In re Application of	:	
KAY, et al.	:	DECISION ON PETITION
U.S. Application No.: 09/807,167	:	
PCT No.: PCT/GB99/03169	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 11 October 1999	:	
Priority Date: 09 October 1998	:	
Attorney Docket No.: 7413-3	:	
For: FLOOR COVERING MATERIAL AND	:	
METHOD FOR PRODUCING SAME	:	

This decision is in response to applicants' "Response to Notice of Missing Parts" filed 16 July 2001. The response is being treated as a petition under 37 CFR 1.47(a).

BACKGROUND

On 11 October 1999, applicant filed international application PCT/GB99/03169, which claimed priority of an earlier application filed 09 October 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 20 April 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 31 March 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 09 April 2001.

On 09 April 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a First Preliminary Amendment and an unexecuted declaration. Applicant also prepaid the \$130.00 surcharge for providing an executed oath or declaration of the inventors later than thirty months from the priority date.

On 30 April 2001, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) and a NOTIFICATION OF DEFECTIVE OATH OR DECLARATION (Form PCT/DO/EO/917) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 16 July 2001, applicant responded with the present response to accept the application absent the signature of joint inventor Grenville SEAGER; a petition for a one-month extension of time and a declaration signed by joint inventors: John Granville KAY; Michael Geoffrey MINETT; Adrian Lance ENTWISTLE and Craig Lee CROSBY. With the filing of the petition for a one-month extension of time and payment of the extension fee, the response is considered to be timely filed.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the requisite \$130 petition fee required by 37 CFR 1.17(I); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing joint inventor; and (4) an oath or declaration executed by each of the signing joint inventors on their behalf and on behalf of the non-signing joint inventor(s). Item 4 has been satisfied.

As to Item 1, applicant has authorized the charging of any relevant fees to Deposit Account No.: 23-3030. Applicant previously paid the surcharge for providing an oath or declaration later than thirty months from the priority date. Therefore, the \$65.00 surcharge provided on 16 July 2001 will be applied to the necessary petition fee for the present petition. As such, an additional \$65.00 will be deducted from Deposit Account No.: 23-3030 as payment of the \$130.00 petition fee required by 37 CFR 1.17(I).

Regarding Item 2 above, MPEP 409.03(d) provides, in part:

Where inability to find or reach a non-signing inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a non-signing inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Such a petition will be dismissed as inappropriate.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the non-signing inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Applicants have not provided any details of attempts to find Mr. Seager. Furthermore, applicants have not presented evidence that a set of the application papers were mailed to him and returned undeliverable. It is possible that a set of papers mailed to the last known address would be forwarded by the British postal service to the inventor's current address. In order to proceed

with the present application absent the signature of Mr. Seager, applicants must provide firsthand and documentary evidence as detailed above showing the efforts made to locate Mr. Seager and obtain his signature.

As to Item 3 above, applicants have not provided the last known address of the non-signing inventor, Mr. Seager.

In light of the above, applicants' petition cannot be granted.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED, without prejudice.**

Applicants are hereby afforded TWO (2) MONTHS from the mail date of this decision to file either 1) an oath or declaration in compliance with 37 CFR 1.497 (a)-(b) signed by all inventors or 2) a renewed petition satisfying all requirements under 37 CFR 1.47(a). Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be directed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter directed to the attention of the PCT Legal Office.



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